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10/579,048	05/09/2006	Minerva M. Yeung	42P17842	6284
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EXAMINER				
LAM, VINH TANG				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/579,048

**Applicant(s)**

YEUNG ET AL.

**Examiner**

VINH T. LAM

**Art Unit**

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 02/12/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims **1-22** are rejected under 35 U.S.C. 101 because:

In the preamble of the Claim **1**, lines 1-2, recites "...a **computer-implemented method** of correlating traditional printed material to a response produced by a **computer system ...**",

in the preamble of the Claim **10**, lines 1-4, recites "...a **computer readable storage medium** having a plurality of machine accessible instructions stored thereon, wherein when the instructions are executed by a processor, the instructions cause the processor to correlate traditional printed material to a response produced by a **computer system ...**", and

in the preamble of the Claim **19**, lines 1-2, recites "... a system for associating a selected object on any printed material to a valid response provided by a **computer system...**"

The specification states that the computer readable storage medium could be a *carrier wave* as stated and defined in the specification (Col.6, [0052]).

Propagation media in the context of this disclosure covers signals and carrier waves, which are not a Manufacture within the meaning of 101, and electrical connections and optical fibers, on which the program is still unavailable to the

processor. In such embodiments, the computer is still unable to act as a computer component and have functionality realized. Therefore, given specification claims 1-22 are rejected under 101 as failing to be limited to embodiments which fall within a statutory category.

To overcome the 101 rejection, the Examiner will suggest deleting the word "carrier wave" from the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims **1**, **10**, and **19** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding Claim Claims **1**, **10**, and **19**, the speciation as originally filed has failed to provide support for the recitation of "...the traditional printed material is **not directly or communicatively coupled to the computer system** ...". The specification does not reasonably convey one skill in the art how to make or use applicant claimed invention for of "...the traditional printed material is **not directly or communicatively coupled to the computer system** ...".

The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims **1, 10, and 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation of Claims **1, 10, and 19** "...the traditional printed material is **not directly or communicatively coupled to the computer system** ..." is not clear.

What does "**...not directly or communicatively coupled to the computer system** ..." mean?

Is the traditional printed material **directly or communicatively coupled to the computer system** as shown in Figure **1**, i.e. Paper Book **104** on Book Holder **106** with Receiver **108** **directly or communicatively coupled to the computer system 102**?

Is the traditional printed material **directly or communicatively coupled to the computer system** as shown by Blocks **308, 408, 508, 706, and 908** in Figures **3, 4, 5, 7, and 9** respectively?

What are the differences in **linkage of objects on the traditional printed material to the computer system** and **directly or communicatively coupled to the computer system**?

What's exactly the applicant's definition of "**...not directly or communicatively coupled to the computer system** ..."?

The information and objects on the traditional printed material must have direct correlations and communications to the computer system.

To further advance prosecution, the Examiner interprets that the traditional printed material has a correlation of positions and wired or wireless communications to the computer system.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims **1-5, 8-14, and 17-22** are rejected under 35 U.S.C. 102(b) as being anticipated by **Ohara et al. (US Patent No. 5739814)**.

Regarding Claims **1** and **10**, (currently amended) **Ohara et al.** teach a computer-implemented method of correlating traditional printed material to a response produced by a computer system (Col. 7, Ln. **35-43**, FIG. **9**) comprising (Claim **1**):

a computer readable storage medium having a plurality of machine accessible instructions stored thereon, wherein when the instructions are executed by a processor,

the instructions cause the processor correlate traditional printed material to a response produced by a computer system (Col. 7, Ln. **35-43, FIG. 9**) by (Claim **10**):

defining an object on a page (Col. 7, Ln. **52-55, FIG. 9**) of the traditional printed material (i.e. pages or sheets in the book, Col. 7, Ln. **5**; or printed data; Col. 7, Ln. **17-19**); and

linking a position of the object on the page (Col. 7, Ln. **26-34, FIGs. 5 & 6**; Col. 7, Ln. **44-47**) and a related response to be performed by the computer system (Col. 7, Ln. **47-51**),

wherein the traditional printed material is not directly or communicatively coupled to the computer system (Col. 7, Ln. **39-43, FIG. 9**), and

wherein the position on the page is defined by a relative position of the traditional printed material to a known physical location of a printed material holder (Col. 7, Ln. **27-34, FIGs. 5 & 6**; Col. 7, Ln. **44-47, FIG. 9**).

Regarding Claims **2** and **11**, (original) **Ohara et al.** teach the computer-implemented method of claim 1 and the medium of claim 10 respectively, wherein the response comprises at least one of rendering audio content, rendering video content, rendering image content, rendering text content, and performing an action by the computer system (Col. 7, Ln. **34-55, FIG. 9**).

Regarding Claims **3** and **12**, (original) **Ohara et al.** teach the computer-implemented method of claim 2 and the medium of claim 11 respectively, further comprising (instructions for (Claim 11)):

generating a multimedia database (Col. 7, Ln. **39-41**, FIG. 9) to store digital multimedia content including at least one of audio content, video content, image content (Col. 7, Ln. **34-37**, FIG. 9), and text content (i.e. pages or sheets in the book, Col. 7, Ln. 5; or printed data; Col. 7, Ln. **17-19**);

a printed material content database to store positional information about objects on the pages and linkage information between the objects (Col. 7, Ln. **27-34**, FIGs. **5 & 6**; Col. 7, Ln. **44-47**, FIG. 9) and at least one of the multimedia contents and actions (Col. 7, Ln. **34-55**, FIG. 9); and

an action library (Col. 7, Ln. **39-41**, FIG. 9) to store directives for actions to be performed on the computer system (Col. 7, Ln. **39-41**, Ln. **45-51**, FIG. 9).

Regarding Claims **4** and **13**, (original) **Ohara et al.** teach the computer-implemented method of claim 2 and the medium of claim 11 respectively, wherein (instructions for (Claim 13)) defining the object on the page comprises (instructions for (Claim 13)) using an electronic pen to outline boundaries of the object on the page (Col. 7, Ln. **52-54**, FIG. 9).

Regarding Claims **5** and **14**, (original) **Ohara et al.** teach the computer-implemented method of claim 2 and the medium of claim 11 respectively, wherein (instructions for (Claim 14)) defining the object on the page comprises (instructions for (Claim 14)) using an electronic pen to select key points on the boundary of the object on the page (i.e. inherent; Col. 7, Ln. **20-34**, FIGs. **5 & 6**).

Regarding Claims **8** and **17**, (original) **Ohara et al.** teach the computer-implemented method of claim 2 and the medium of claim 11 respectively, wherein the



printed material comprises a traditional paper book (i.e. pages or sheets in the book, Col. 7, Ln. 5; or printed data; Col. 7, Ln. **17-19**).

Regarding Claims **9** and **18**, (original) **Ohara et al.** teach the computer-implemented method of claim 2 the medium of claim 11 respectively, wherein the printed material comprises material generated by a user (i.e. drawing, Col. 5, Ln. **27-31**).

Regarding Claim **19**, (currently amended) **Ohara et al.** teach a system for associating a selected object on any printed material to a valid response provided by a computer system (Col. 7, Ln. **35-43**, FIG. **9**) comprising:

a pointing device (i.e. pen **24**; Col. 7, Ln. **54**, FIG. **9**) to determine a position (Col. 7, Ln. **29-34**, FIG. **9**) on the printed material (i.e. pages or sheets in the book, Col. 7, Ln. **5**; or printed data; Col. 7, Ln. **17-19**), wherein the printed material is not directly or communicatively coupled to the computer system (Col. 7, Ln. **39-43**, FIG. **9**), and wherein the position on the printed material is defined by a relative position of the printed material to a known physical location of a printed material holder (Col. 7, Ln. **27-34**, FIGs. **5 & 6**; Col. 7, Ln. **44-47**, FIG. **9**);

a communicating device coupled to the printed material holder to transmit the position to the computer system (Col. 7, Ln. **41-43**, FIG. **9**);

a maker component to define an object on a page of the printed material; and to link a position of the object on the page and a related response to be performed by the computer system (Col. 7, Ln. **54-59**, FIG. **9**); and

a player component to correlate the pointed position to selected content associated with the printed material, the selected content being accessible by the computer system (Col. 7, Ln. **29-34**, FIG. 9); and

to provide a valid response to a user based at least in part on the pointed position and the correlated content, wherein the valid response includes at least one of rendering audio content, rendering video content, rendering image content, rendering text content, and performing an action by the computer system (Col. 7, Ln. **35-38**, Ln. **45-51**, FIG. 9).

Regarding Claim **20**, (original) **Ohara et al.** teach the system of claim 19, wherein the pointing device comprises an electronic pen (Col. 7, Ln. **54-59**, FIG. 9).

Regarding Claim **21**, (original) **Ohara et al.** teach the system of claim 19, further comprising a multimedia database to store digital multimedia content (Col. 7, Ln. **45-49**, FIG. 9), a printed material content database to store positional information about objects on the pages (Col. 7, Ln. **54-59**, FIG. 9).and linkage information between the objects and at least one of the multimedia contents and actions, and an action library to store directives for actions to be performed on the system (Col. 7, Ln. **45-49**, FIG. 9).

Regarding Claim **22**, (original) **Ohara et al.** teach the system of claim 19, wherein the printed material comprises a traditional paper book (i.e. pages or sheets in the book, Col. 7, Ln. **5**; or printed data; Col. 7, Ln. **17-19**).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **6-7** and **15-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ohara et al. (US Patent No. 5739814)**.

Regarding Claims **6** and **15**, (original) **Ohara et al.** teach the computer-implemented method of claim 2 and the medium of claim 11 respectively.

Although **Ohara et al.** do not teach that (instructions for (Claim 15)) defining the object on the page comprises (instructions for (Claim 15)) using a mouse to manipulate a graphical object on a display to encapsulate the boundary of the object on the page as displayed on the display.

However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace **Ohara et al.'s** touch pen with a mouse to manipulate a graphical object on a display to encapsulate the boundary of the object on the page as displayed on the display for the benefit of utilizing an alternative input device.

Regarding Claims **7** and **16**, (original) **Ohara et al.** teach the computer-implemented method of claim 2 and the medium of claim 11 respectively.

Although **Ohara et al.** do not teach (instructions for (Claim 16)) defining the object on the page comprises (instructions for (Claim 16)) using a mouse to select key points on the boundary of the object on the page as displayed on a display.

However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace **Ohara et al.'s** touch pen with a mouse to select key points on the boundary of the object on the page as displayed on a display for the benefit of utilizing an alternative input device.

#### ***Response to Arguments***

6. Applicant's arguments, see Page 7 filed 02/12/2009, with respect to Drawing and Specification Objections have been fully considered and are persuasive. The Objections of Drawing and Specification has been withdrawn.
7. Applicant's arguments, see Page 7 filed 02/12/2009, with respect to 35 USC 101 Rejection have been fully considered and are NOT persuasive.

All of applicant's claims direct to a method, storage medium, and a system associated with a computer or "**machine readable medium**" which includes a **carrier wave** as stated and defined in the Specification (Col.6, [0052]) is a **non-statutory** even the preambles of the claims do not include the phrase **carrier wave**, the claims are part of the Specification, however.

To overcome 35 USC 101 Rejection, applicant must amend the Specification, namely the phrase **carrier wave** must be deleted from the Specification.

8. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINH T. LAM whose telephone number is (571)270-3704. The examiner can normally be reached on M-F (7:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amare Mengistu can be reached on (571) 272-7674. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VTL/

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